

**REMARKS**

Claims 1 and 3-10 are pending in this application and under consideration. Claims 1, 3, 9, and 10 have been amended. Support for the amendments to claims 1, 3, 9, and 10 may be found in paragraph [0007] of the specification as originally filed, and in claim 2. Claim 2 is canceled herein without prejudice or disclaimer. Reconsideration is requested based on the foregoing amendment and the following remarks.

**Response to Arguments:**

The Applicants appreciate the consideration given to their arguments. Further reconsideration is requested.

**Claim Rejections - 35 U.S.C. § 102:**

Claims 1 and 3-10 were rejected under 35 U.S.C. § 102(e) as anticipated by US Patent Application Publication No. 2003/0135569 to Khakoo et al. (hereinafter "Khakoo"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration of the rejection is earnestly solicited.

The fifth clause of claim 1 recites:

Wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message.

Khakoo neither teaches, discloses, nor suggests, "wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message," as recited in claim 1. In Khakoo, rather, the *presence database 200* maintains information for each user in the community, including the availability of each user to receive instant messages. There is no evidence in Khakoo that *users* have any control over the information maintained in the presence database 200 at all. In particular, as described in paragraph [0020]:

As indicated above, the presence database 200 maintains information for each user in the community, including the availability of each user to receive instant messages. As shown in FIG. 2, the presence database 200 includes a plurality of records, such as record 210, each associated with a different user.

Since, in Khakoo, the presence database 200 maintains information for each user in the community, including the availability of each user to receive instant messages, the availability status in Khakoo is not "selectable for activation by the predetermined recipient of the call and/or message," as recited in claim 1.

In addition, in Khakoo, the *presence database 200* indicates the user's presence in field 240. There is no evidence in Khakoo that *users* have any control over whether their presence is indicated or not. In particular, as described further in paragraph [0020]:

For each user, identified, for example, by name in field 230, the presence database 200 indicates the user's presence in field 240, corresponding device address and capabilities in fields 250 and 260, respectively, and the user's voice mailbox in field 270.

Since, in Khakoo, the presence database 200 indicates the user's presence in field 240, the availability status in Khakoo is not "selectable for activation by the predetermined recipient of the call and/or message," as recited in claim 1.

Furthermore, in Khakoo, the *presence entry in field 240* indicates whether the user is present at a given device registered for the user. There is no evidence in Khakoo that *users* have any control over whether their presence is indicated in the presence entry in field 240 or not. In particular, as described further in paragraph [0020]:

The presence entry in field 240 indicates whether the user is present at a given device registered for the user. The device address in field 250 indicates the address of each device that is available for receiving instant messages for the user. The address can be any location or connection means, such as a phone number or URL, for example. The device capability in field 260 indicates the capability of the device, such as whether the device is text or voice or video capable (or some combination of the foregoing), including email and fax capable devices. Finally, the voice mailbox in field 270 indicates the address of the voice mailbox for the user.

Since, in Khakoo, the presence entry in field 240 indicates whether the user is present at a given device registered for the user, the availability status in Khakoo is not "selectable for activation by the predetermined recipient of the call and/or message," as recited in claim 1.

Furthermore, in Khakoo, the instant message delivery server 100 performs a *test* during step 310 to determine if the recipient is available. The fact that the instant message delivery server 100 has to perform a test to determine if the recipient is available militates against the availability status in Khakoo being "selectable for activation by the predetermined recipient of the call and/or message," as recited in claim 1. In particular, as described in paragraph [0022]:

The instant message delivery server 100 performs a test during step 310 to determine if the recipient is available.

Since, in Khakoo, the instant message delivery server 100 performs a test during step 310 to determine if the recipient is available, the availability status in Khakoo is not "selectable for activation by the predetermined recipient of the call and/or message," as recited in claim 1.

Claim 1 is thus submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3-8 depend from claim 1 and add further distinguishing elements. Claims 3-8 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3-8 is also earnestly solicited.

**Claim 9:**

The fifth clause of claim 9 recites:

Wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message.

Khakoo neither teaches, discloses, nor suggests, "wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message," as discussed above with respect to the rejection of claim 1. Claim 9 is thus also submitted to be allowable for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 9 is earnestly solicited.

**Claim 10:**

The fifth clause of claim 10 recites:

Wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message.

Khakoo neither teaches, discloses, nor suggests, "wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message," as discussed above with respect to the rejection of claim 1. Claim 10 is thus also submitted to be allowable for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 10 is earnestly solicited.

**Claim Rejections - 35 U.S.C. § 103:**

Claims 5 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Khakoo in view of U.S. Patent Publication No. 2003/0076941 to Tiliks et al. (hereinafter "Tiliks"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

Claims 5 and 8 depend from claim 1 and add further distinguishing elements. Khakoo neither teaches, discloses, nor suggests, "wherein the availability status is selectable for

activation by the predetermined recipient of the call and/or message,” as discussed above with respect to the rejection of claim 1. Tiliks does not either, and thus cannot make up for the deficiencies of Khakoo with respect to claims 5 and 8.

In Tiliks, rather, calls are connected if the telephone number from which they originate matches no number on a restricted list. In particular, as described in paragraph [0056]:

When the outside telephone number does not match the at least one restricted telephone number, the call is connected between the subscriber telephone number and the outside telephone number. When the outside telephone number matches the at least one restricted telephone number, the call data is stored and entry of the personal identification number is requested.

Since, in Tiliks, calls are connected if the telephone number from which they originate matches no number on a restricted list, the availability status in Tiliks is not “selectable for activation by the predetermined recipient of the call and/or message,” as recited in claim 1.

All that matters in Tiliks, if the telephone number is restricted, is whether the recipient *has* the personal identification number, not the availability of a predetermined recipient. The recipient may be all ready and waiting to receive the call, i.e. he may be more than available. If he can't produce the PIN, however, he doesn't get to talk. This is to be contrasted with claim 1, which recites, “wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message.” Claims 5 and 8 are thus also submitted to be allowable. Withdrawal of the rejection of claims 5 and 8 is also earnestly solicited.

#### **Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all claims 1 and 3-10 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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